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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

9

Application Number

10/643,383

Filing Date

August 19, 2003

First Named Inventor

Daniel J. White et al.

Art Unit

1725

Examiner Name

C. Shaw

Attorney Docket Number

TN-2491A

**ENCLOSURES (check all that apply)**☒ Fee Transmittal Form☐ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/  
Incomplete Application☐ Reply to Missing Parts  
under 37 CFR1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ Landscape Table on CD☐ After Allowance Communication to TC☒ Appeal Communication to Board  
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(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s)  
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Firm

Black &amp; Decker Inc.

Signature

Printed Name

Adan Ayala, Esq.

Date

June 22, 2006

Reg.  
No.

38,373

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Date

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# FREE TRANSMITTAL for FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 500

## Complete if Known

Application Number	10/643,383
Filing Date	August 19, 2003
First Named Inventor	Daniel J. White et al.
Examiner Name	C. Shaw
Art Unit	1725
Attorney Docket No.	TN-2491A

## METHOD OF PAYMENT (check all that apply)

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## FEE CALCULATION

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

### 2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee(\$)</b>
_____ -20 or HP= _____	x _____	= _____
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee(\$)</b>
_____ - 3 or HP= _____	x _____	= _____
HP = highest number of independent claims paid for, if greater than 3.		

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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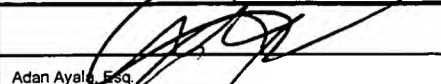
Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Reply Brief

Fees Paid (\$)

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## SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	38,373	Telephone	410-716-2368
Name (Print/Type)	Adan Ayala, Esq.	Date	June 22, 2006		

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UTILITY PATENT

B&D No. TN2491A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: **Daniel J. WHITE et al.**

Serial No.: **10/643,383**

Examiner: **C. Shaw**

Filed: **August 19, 2003**


Group Art Unit: **1725**

For: **BATTERY PACK AND METHOD  
FOR CONSTRUCTING SAME**

Assistant Commissioner for Patents  
Washington, DC 20231

**REPLY BRIEF**

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 6-22-06

  
Adan Ayala

Dear Sir:

This is in response to the Examiner's Answer mailed on May 2, 2006.

**A. Claim 11 is Patentable under 35 USC § 103 over Alexandres in view of the Admitted Prior Art ("APA") and Hooke.**

The Board should reverse the Examiner's improper final rejection of Claim 11 under 35 USC § 103 based on the combination of Alexandres/APA/Hooke. This is because, even if the three references were combined, such combination would not result in the claimed invention.

The Examiner is improperly interpreting Alexandres and assuming unsupported facts. As admitted by the Examiner, Alexandres "does not discuss the details of the cell 44." Accordingly, the Examiner is guessing the location and size of the Alexandres weld area, especially since the size

of the weld area may change due to manufacturing tolerances. Because of that, persons of ordinary skill in the art would assume that the entire top of the cell button cap constitutes the weld area when designing a battery pack. Accordingly, the person of ordinary skill would consider the position of the Alexandres electrodes to be within the cell's weld area.

Being that Claim 11 requires "disposing a first electrode on the strap outside of the weld area," a person of ordinary skill in the art would not consider Alexandres to teach or suggest such claimed element. Therefore, the Alexandres/APA/Hooke cannot render Claim 11 unpatentable.

Even assuming for the sake of argument that the Alexandres electrodes 66, 68, 70 are placed outside of the weld area, Alexandres still does not disclose placing any electrodes on the cell, as all three electrodes are placed on the strap. The Examiner argues that the electrode is on the cell, even though there is an intervening electrode strap.

Admittedly, during patent examination, the pending claims must be given their "broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The Specification however discloses and shows an electrode 16C being directly "disposed on an area of cell 11" without an intervening connecting strap. Specification, p. 4, lns. 6-7 and FIGS. 2B-2C. This is distinguished from strap electrode 16S, which is "disposed on the strap 13." *Id.* In other words, the Specification does not consider an electrode 16S which is disposed on strap 13, which is then disposed cell 11, to be disposed on cell 11, unlike electrode 16C.

Because of that distinction, persons of ordinary skill in the art would interpret Claim 11 to require the electrode to be placed directly on the cell and/or without an intervening connecting strap, contrary to the Examiner's argument. Therefore, the broadest reasonable interpretation

that can be given to the “disposing ... a second electrode on the at least one cell” element of Claim 11 is that the electrode must be placed directly on the cell, or at least not on the connecting strap.

Under either interpretation, Alexandres still fails to show such feature. Accordingly, the Alexandres/APA/Hooke combination does not show all claimed elements of Claim 11. Therefore, such combination cannot render Claim 11 unpatentable.

**B. Claim 12 is Patentable under 35 USC § 103 over Alexandres in view of the APA and Hooke.**

The Board should reverse the Examiner’s improper final rejection of Claim 12 under 35 USC § 103 based on the combination of Alexandres/APA/Hooke. This is because, even if the three references were combined, such combination would not result in the claimed invention. Therefore, the Examiner’s rejection was improper and should be reversed.

In addition to the missing elements discussed above, the Alexandres/APA/Hooke combination does not show the second electrode contacting a side of the cell. The Examiner alleges that, due to the breadth of the claimed language, Alexandres shows the second electrode contacting a side of the cell.

This is incorrect. As seen in FIG. 2 of Alexandres and as discussed above, all the Alexandres electrodes contact the strap, not the cell. If the electrodes do not contact the cell, the second electrode cannot contact the side of the cell.

By contradistinction, Claim 12 requires that “the second electrode contact[] a side of the at least one cell.” Since such feature is not shown by Alexandres, as alleged by the Examiner, neither it nor the Alexandres/APA/Hooke combination can render Claim 12 unpatentable.

**C. Claim 13 is Patentable under 35 USC § 103 over Alexandres in view of the APA and Hooke.**

The Board should reverse the Examiner's improper final rejection of Claim 13 under 35 USC § 103 based on the combination of Alexandres/APA/Hooke. This is because, even if the three references were combined, such combination would not result in the claimed invention. Therefore, the Examiner's rejection was improper and should be reversed.

In addition to the missing elements discussed above, the Alexandres/APA/Hooke combination does not show the second electrode contacting a periphery of the cell. The Examiner alleges that, due to the breadth of the claimed language, Alexandres shows the second electrode contacting a periphery of the cell.

This is incorrect. As seen in FIG. 2 of Alexandres, all the electrodes contact the strap, not the cell. If the electrodes do not contact the cell, the second electrode cannot contact the periphery of the cell.

Furthermore, the Examiner is interpreting "periphery" too broadly as he alleges that each electrode, which is closer to the center of the cell than to the outer edge of the cell, is in the "top periphery of the cell." Such interpretation violates the plain meaning of the word "periphery."

During examination, words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). Because the Applicants/Appellant have not provided a definition for "periphery" in the specification, the plain meaning must be used.

## UTILITY PATENT

B&D No. TN2491A

As shown in the attached print-outs, the Merriam-Webster online dictionary ([www.m-w.com](http://www.m-w.com)) defines “periphery” as “the perimeter of a circle or other closed curve...the external boundary or surface of a body.” “Perimeter” in turn means “the boundary of a closed plane figure.” In other words, “periphery” means the outer edge of the cell.

Contrary to the Examiner’s arguments, the Alexandres electrodes are not placed on the outer edge of the cell. Accordingly, Alexandres cannot teach or suggest an electrode contacting a periphery of a cell. By contradistinction, Claim 13 requires that “the second electrode contact[] a periphery of the at least one cell.” Since such feature is not shown by Alexandres, as alleged by the Examiner, neither it nor the Alexandres/APA/Hooke combination can render Claim 13 unpatentable.

Based on the foregoing, Applicants/Appellant urge the Board to rule that Claims 11-13 are patentable over the combination of Alexandres/APA/Hooke.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Adan Ayala', written over a horizontal line.

Adan Ayala

PTO Reg. No. 38,373

Attorney for Applicants/Appellant



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## Merriam-Webster Online Dictionary

### periphery

One entry found for periphery.

Main Entry: **pe·riph·ery**

Pronunciation: p&- 'ri-f (&-) rE

Function: *noun*

Inflected Form(s): *plural -eries*

Etymology: Middle French *peripherie*, from Late Latin *peripheria*, from Greek *periphēreia*, from *peripherein* to carry around, from *peri-* + *pherein* to carry -- more at **BEAR**  
**1** : the perimeter of a circle or other closed curve; *also* : the perimeter of a polygon

**2** : the external boundary or surface of a body

**3 a** : the outward bounds of something as distinguished from its internal regions or center : **CONFINES** **b** : an area lying beyond the strict limits of a thing

For **More Information on "periphery"** go to [Britannica.com](http://Britannica.com)

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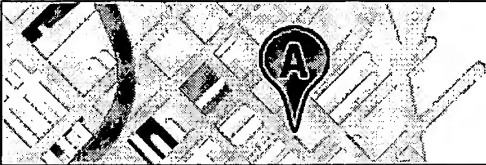
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## perimeter

One entry found for **perimeter**.Main Entry: **pe·rim·e·ter**

Pronunciation: p&amp;- 'ri-m&amp;-t&amp;r

Function: *noun*

Etymology: Middle English *perimetre*, from Latin *perimetros*, from Greek, from *peri-* + *metron* measure -- more at [MEASURE](#)

**1 a** : the boundary of a closed plane figure **b** : the length of a perimeter

**2** : a line or strip bounding or protecting an area

**3** : outer limits -- often used in plural

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